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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/839,451	04/20/2001	David Cortis	4232-4002	4838
7590 02/26/2008 MORGAN & FINNEGAN, L.L.P. 345 Park Avenue New York, NY 10154-0053			EXAMINER CHAMPAGNE, DONALD	
			ART UNIT 3622	PAPER NUMBER
			MAIL DATE 02/26/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

09/839,451

**Applicant(s)**

CORTS ET AL.

**Examiner**

Donald L. Champagne

**Art Unit**

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-212 is/are pending in the application.
- 4a) Of the above claim(s) 32-67 and 130-212 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 and 68-129 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-84C)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 15 January 2008 has been entered.

### ***Claim Rejections - 35 USC § 102 and 35 USC § 103***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-4, 6-31, 68-74, 76-102 and 104-129 are rejected under 35 U.S.C. 102(e) as being anticipated by Abecassis (US006192340B1).
5. Abecassis teaches (independent claims 1, 29-31, 68, 96-99 and 127-129) a method, apparatus, and computer readable medium encoded with said method, for coordinating transmissions of supplemental digital data by a service provider, where the supplemental

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digital data being transmitted to at least a listener with broadcast data by at least one broadcaster, the method comprising:

receiving schedule information (*Providing a broadcast schedule*, col. 16 lines 40-46) for at least one broadcaster (a *plurality of providers 411-413*, col. 11 lines 1-2, and *one or more Multimedia Players 431 delivering radio-on-demand services*, col. 11 lines 22-30, said service including *broadcasted programs*, col. 3 lines 32-34 )<sup>1</sup>, at the service provider (*provider 411-413*, col. 11 line 23), the schedule information including a broadcast schedule of the broadcast data conducted by the at least one broadcaster at the scheduled time (inherently, since a broadcast schedule is, by definition, "a broadcast schedule of the broadcast data", and is inherently "conducted by the at least one broadcaster at the scheduled time");

identifying, from the received schedule information, the broadcast data to be transmitted (*audio items for downloading*, col. 16 line 42) to the listener/user by the at least one broadcaster;

determining the supplemental digital data (*information*, col. 20 lines 58-61, or col. 21 lines 63-65 or col. 17 lines 10-12) to be transmitted to the listener of the broadcast data (any one of the *end users 431-438*, col. 11 lines 1-3) having a digital data receiver (*digital radio-on-demand player*, col. 8 lines 49-51) base on the broadcast data identified at the identifying step (*broadcasted information*, col. 20 line 59 or *musical items*, col. 21 lines 64-65 or *song being played*, col. 17 lines 11-12); and

transmitting at least a portion of the supplemental data to the at least one broadcaster (*the received informational items*, col. 2 line 65 to col. 3 lines 4, where *audio library* is defined at col. 2 lines 36-53) prior to the scheduled time thereby enabling the at least one broadcaster to transmit the supplemental digital data to the listener at the scheduled time in a separate channel from channel for the broadcast data (a *plurality of communications streams*, col. 11 line 34, where *streams* reads on "channels"),

wherein the separate channel for the supplemental digital data is configured to transmit the supplemental digital data simultaneously with the channel for the broadcast data (*simultaneously access a variety of audio and information resources*, col. 11 lines 22-30, and a *contemporaneous playing of user selected broadcasted programs*, col. 3 lines 32-34).

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6. For independent claims 99 and 127-129, *Multimedia Player 100* reads on a traffic management system (Fig. 1 and the explanation beginning at col. 5 line 25).
7. Abecassis also teaches at the citations given above claims 8-10, 78-80 and 106-108; claims 14-17, 84-87 and 112-116; claims 19-21 and 117-119; claims 22, 23, 89, 90 120 and 121, where the seller of advertising data is nonfunctional and was accordingly not given patentable weight; and claims 24-28, 91-95 and 122-126.
8. Abecassis also teaches claims 2-4, 11-13, 18, 72-74, 81-83, 88, 100-102, 109-111 and 116 (col. 1 lines 34-67); and claims 6, 7, 76, 77, 104 and 105 (col. 11 line 19).
9. Claims 5, 75 and 103 are rejected under 35 U.S.C. 103(a) as being obvious over Abecassis (US005819160A). Abecassis does not teach side band radio broadcasting. This limitation was common at the time of the instant invention. Official notice of this common knowledge or well known in the art statement was taken in the Office action mailed 14 December 2006 (para. 13). This statement is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate. (MPEP 2144.03.C.)

### ***Response to Arguments***

10. Applicants' arguments filed with an amendment on 15 January 2009 have been fully considered but they are not persuasive. Most of the arguments have been considered by revising the rejection.
11. Applicants argue (p. 47, top) that "service provider" should be interpreted as someone "other than the broadcaster and the listener". First, no support was found in the specification for this interpretation. Indeed, the term "service provider" is not even disclosed in the application as filed.
12. Second, "other than" is not explained, but presumably means that the "service provider", "user" and "broadcaster" are legally separate entities, and that at least the service provider and broadcaster are businesses. No patentable weight can be given to this interpretation because it is essentially an ownership limitation. Ownership is inherently indefinite because it is not concrete (predictable). The US Supreme Court has found that "A corporation is an

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<sup>1</sup> Also, from col. 11 lines 3-12: *Participants in the network ... are both providers and end users ...*

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artificial being, invisible, intangible and existing only in contemplation of law.” *CTS Corp. v. Dynamics Corp. of America*, 481 U.S. 69, 89, 107 S. Ct. 1637, 1649-1650 (1987) (citing *Trustees of Dartmouth College v. Woodward*, 17 U.S. (4 Wheat) 518 (1819)). A “business” can be created, merged, dispersed or destroyed at human whim. Hence, in accordance with the *State Street* decision (MPEP 2106.II.A), ownership limitations cannot impart patentability. In the instant case, even if the service provider were “other than” the broadcaster, one could buy the other. What would then happen to a patent based on an “other than” limitation?

### **Conclusion**

13. This is a continuation of applicant's earlier Application No. 09839451. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
14. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.
15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L. Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 9:30 AM to 8 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at [donald.champagne@uspto.gov](mailto:donald.champagne@uspto.gov), and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717. The fax phone number for all *formal* matters is 571-273-8300.
16. The examiner's supervisor, Eric Stamber, can be reached on 571-272-6724.

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17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
18. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that "disposal or clarification for appeal may be accomplished with only nominal further consideration" (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.
19. Applicant may have after final arguments considered and amendments entered by filing an RCE.
20. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, [www.uspto.gov](http://www.uspto.gov). At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

9 February 2008

/Donald L. Champagne/  
Primary Examiner, Art Unit 3622